

REMARKS

Claims 19-37 are pending in this application. Claims 19, 30, 31, 33 and 36 have been amended. Applicants note that the amendments to the claims were made in order to address the Examiner rejection under 35 U.S.C. 101, and no new matter (or new issue) is presented by the amendments. Reconsideration of the present application in view of the foregoing amendments and following remarks is respectfully requested.

Claims 19-37 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

With respect to the independent method claims 19 and 30, the Examiner contends that these claims only recite abstract ideas. While Applicants note that the Examiner's contention is clearly contradicted by the recitation of the phrase "encoding, decoding and transmitting location information of a data packet," which necessarily implies (particularly when read in light of the specification) an electronic data handling, Applicant have amended claim 19 to explicitly recite "electronically encoding, decoding and transmitting location information of objects for a map, the method comprising: at least one of electronically encoding, decoding and transmitting location information of an electronic data packet." Independent claim 30 has been amended to recite substantially similar features. Applicants respectfully submit that the subject matter of amended claims 19 and 30 is integrally tied to a technological art (electronic data handling) that results in a practical application producing a concrete, useful and tangible result.

With respect to claims 31, 33 and 36, which recite "an encoding device," "a decoding device," and "a system," respectively, Applicants respectfully submit that there is no reasonable interpretation of the claim language that would support the Examiner's contention that the claimed subject matter is "an abstract idea, without need for physical computing equipment," as asserted by the Examiner: "a device" and "a system" are clearly tangible subjects. However, in order to facilitate expedited prosecution of the present application, Applicants have amended claims 31 and 33 to recite that the device is "an electronic encoding device" and "an electronic decoding device," respectively, to electronically encode/decode location information of an electronic data packet. Claim 36 has been similarly amended to recite an "electronic system for encoding, decoding and transmitting location information," the system including "an arrangement to electronically

encode, decode and transmit location information of an electronic data packet.” Applicants respectfully submit that the subject matter of amended claims 31, 33 and 36 is integrally tied to a technological art (device/system for electronic data handling) that results in a practical application producing a concrete, useful and tangible result.

For at least the foregoing reasons, Applicants submit that claims 19, 30, 31, 33 and 36, as well as dependent claims 20-29, 32, 34-35 and 37, are in compliance with 35 U.S.C. § 101.

Claims 19, 28-31, 33 and 36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,272,548 (“Cotter”). It is respectfully submitted that the claims 19, 28-31, 33 and 36 are not anticipated by Cotter for at least the following reasons.

To anticipate a claim under § 102(e), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 703 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended claim 19 recites the following:

19. A method for at least one of electronically encoding, decoding and transmitting location information of objects for a map, the method comprising:
at least one of electronically encoding, decoding and transmitting location information of an electronic data packet, the location information

including locating information and description information, wherein the data packet separately contains the locating information and the description information, and **includes assignment information** for assigning at least a part of the locating information to at least a part of the description information.

Independent claims 30, 31, 33 and 36 recite features substantially similar to the above-recited features of claim 19, i.e., **“the location information including locating information and description information, wherein the data packet** separately contains the locating information and the description information, and **includes assignment information** for assigning at least a part of the locating information to at least a part of the description information.” In Applicants’ claimed invention, the **“location information”** clearly includes **three component** information, i.e., the locating information, the description information, and the assignment information. Applicants respectfully submit that Cotter does not teach or suggest these claimed features, as explained in detail below.

Cotter discloses a method of self-routing a message, in which method the message includes a destination address and additionally some elementary information about the general directional bearings. (Col. 5, l. 58-64). In support of the anticipation rejection, the Examiner contends that the following disclosures of Cotter teach the claimed features: a) destination address of Cotter is equivalent to the claimed “locating information”; b) “each packet carries some elementary information about the general direction of its destination,” so this “disclosure” is equivalent to the claimed “description information”; and c) col. 6, lines 15-36 of Cotter (which section indicates that the destination address is in the header) teaches the claimed “assignment information.” However, the data packet of Cotter includes, at best, only two types of information, i.e., the destination address and the directional bearings. (Col. 6, l. 16-18). In any case, the disclosure of Cotter simply does not teach the claimed features of a **“location information”** which includes **three component** information, i.e., the locating information, the description information, and the assignment information. In this regard, it should be noted that the claimed “locating information” is the information regarding where to find the location, which is completely unrelated to the destination address of Cotter: the destination address is a network address where the data packet will end up. Furthermore, the claimed “description information” is the information which describes the location, which is completely unrelated to the “direction information” of Cotter: the direction information of Cotter merely shows the general direction of the destination, and the direction information

has nothing to do with description of the location. In addition, the claimed “assignment information” is the information which provides a connection between the locating information and the description information, which has nothing to do with the disclosure of Cotter that the destination address is in the header.

For at least the foregoing reasons, there is no reasonable interpretation of Cotter that would support the Examiner’s anticipation rejection of claims 19, 30, 31, 33 and 36, as well as dependent claims 28-29.

Claims 20-27, 32, 34, 35 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cotter in view of U.S. Patent No. 6,169,515 (“Mannings”). It is respectfully submitted that the claims 20-27, 32, 34, 35 and 37 are not rendered unpatentable by the combination of Cotter and Mannings, for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Applicants note that claims 20-27, 32, 34, 35 and 37 ultimately depend from independent claim 19, 31 or 33. Furthermore, Mannings clearly fails to remedy the deficiencies of Cotter as applied against independent claims 19, 31 and 33. Accordingly, the combination of Cotter and Mannings fails to render obvious dependent claims 20-27, 32, 34, 35 and 37.

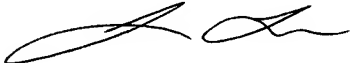
For at least the foregoing reasons, Applicants respectfully submit that the obviousness rejection of claims 20-27, 32, 34, 35 and 37 should be withdrawn.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all pending claims 19-37 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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